REMARKS

Claims 5 and 12 have been amended herein. Claims 21-53 have been added. Claims 1-53 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claim 5 has been amended to correct a typographical error.

Claim 12 has been amended to have the recited terms correspond to the terms used in the Specification.

Support for these amendments is found in the original claims, Specification, and drawings.

Amendments to Specification

The paragraph beginning on page 1 at line 2 has been amended to correct a typographical error. The filing year for Provisional Application No. 60/465,733 has been corrected to replace "2002" with --2003--.

Rejections Pursuant To 35 U.S.C. § 112

In the Action, claim 12 was rejected pursuant to 35 U.S.C. § 112, second paragraph. It was asserted in the Action that claim 12 was indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

The term "non-standard" is sufficiently definite in view of the discussion of this feature in the Specification. For example, in the paragraph beginning at page 63, line 10, the Specification clearly discloses that such non-standard imbedded instructions as claimed in claim 12 correspond

to instructions which "do not conform to published standards and/or which are generally nonpublic". Thus Applicants respectfully submit that the recitation of the term "non-standard" in claim 12 is sufficiently clear and definite in view of the Specification.

However, even though the claims as originally presented are believed to satisfy the statutory mandate, claim 12 has been amended herein to even more clearly recite the identical terms discussed in the Specification. Thus the phrase "non-standard imbedded instructions" has been replaced with --nonstandard embedded instructions-- as used in the Specification at page 63, lines 13-15, and page 15, line 3.

The amendment presented herein is a clarification and does not narrow the scope of the claim. It is respectfully submitted that all the pending claims are sufficiently definite and that the rejection pursuant to 35 U.S.C. § 112 should be withdrawn.

Subject Matter Indicated To Be Allowable

It was indicated in the Action that claims 5, 8, 9 and 16 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Acknowledgment of allowable subject matter is greatly appreciated.

The subject matter recited in claims 5, 8 and 16 have been rewritten in independent form as new claims 21, 22, and 24 respectively, and each includes all the material limitations of the respective original base claim. New claim 23 depends from claim 22 and corresponds to allowable claim 9. New claim 25 depends from claim 24 and corresponds to original claim 17. It is respectfully submitted that pending claims 21-25 are allowable.

In addition, please note that with respect to claim 5, the phrase "current date" is recited not "current data" as mentioned in the Action under the Allowable Subject Matter heading. Also

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with respect to claim 8, encryption and decryption of "service manual data" is recited and not "diagnostic data" as mentioned in the Action under the Allowable Subject Matter heading.

The Pending Claims Are Not Obvious in View of the Applied Art

Claims 1-4, 6, 7, 10, 11, 13-15 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coutts, US 5,563,393 in view of Enta, U.S. 5,983,197.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Coutts as modified by Enta as applied to claim 1, in view of Simmons, U.S. 6,765,593.

These rejections are respectfully traversed.

Brief Description of the Invention

With respect to the pending claims, exemplary embodiments may include a diagnostic article (98) such as a CD, DVD, smart card, portable memory device, compact flash card, portable hard drive, portable computing device, memory module, or any other portable device (Figure 4; Page 11, lines 14-17; Page 60, line 21 – Page 61, line 2). When the diagnostic article is placed in operative connection with an automated banking machine such as an ATM (10), the diagnostic article is operative to cause at least one controller (72) in the machine to enable access to diagnostic data (78) stored in the machine and to enable output of indicia (Figures 19-22) to a user through at least one output device responsive to the service data. The accessed diagnostic data concerns operational characteristics of at least one transaction function device of the machine (Page 59, line 16 – page 60, line 7). Examples of transaction function devices may include a currency dispenser device (54), a card reader (26), a deposit accepting device, and input and output devices (30, 32, 36) associated with a user interface of the ATM.

The Applied References Do Not Disclose or Suggest
the Features and Relationships Recited in Applicants' Claims

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The Coutts Reference

Coutts is directed to an interface device (12) for use by an operator in carrying out maintenance of an ATM (10). Coutts teaches that the interface device is separate from the ATM and communicates with the ATM in a contactless manner such as by using radio frequency (Column 2, lines 30-45). The interface device provides the operator with a sequence of instructions. Upon detection with a sensor that a particular instruction has been carried out by the operator, the ATM provides a configuration signal to the user interface device. The user interface device waits for receipt of the confirmation signal from the ATM prior to displaying the next instruction in the sequence (Abstract; Column 4, lines 10-18). The sensors (22-44) of the ATM provide information on the state of health of the ATM to a central processing unit (45) which in turn causes appropriate information signals to be transmitted to the interface device (Column 4, lines 6-9; Column 6, lines 12-15).

The Enta Reference

Enta is directed to a monitoring center (5) (Figure 1) which is operative to remotely monitor failure information and cash reserve information for a number of automated transaction machines (1). Based on monitored information and provided criteria, the monitoring center is operative to cause a service person to be dispatched to the automated transaction machines. The operations performed at the monitoring center (5) are achieved through control performed by a computer program in the computer which functions the monitoring center. This computer program may be installed on the computer of the monitoring center from a floppy disk or CD ROM. (Column 6, lines 45-49).

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The Simmons Reference

Simmons is directed to a method and system for evaluating the serviceability of a system.

The Pending Claims Are Not Obvious Over
Coutts in view of Enta

In the Action claims 1-4, 6, 7, 10, 11, 13-15 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coutts in view of Enta. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretations of Coutts and Enta. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

Claim 1

Claim 1 is an independent claim which is directed to an apparatus. The Action asserts that Coutts teaches a handheld operator interface device (12) which requests diagnostic data from an ATM (10). The Action also asserts that Coutts does not teach direct contact, but instead teaches employing radio transceivers. In addition, the Action asserts that Enta teaches

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diagnostics of ATMs with communication by contact and much prior art (not cited in the Action) illustrated that contact and non-contact varieties of data exchange can be interchanged.

The Action further asserts that in view of Enta's teaching, it would have been obvious to on of ordinary skill in the art at the time the invention was made to include the old and well-known contact-based communications because these are more secure than wireless.

Applicants respectfully disagree. Claim 1 does not recite and therefore is not limited in scope to an apparatus which requires direct contact between the diagnostic article and an automated banking machine. Applicants disagree with all undue limitations implied by the assertions presented in the Action with respect to claim 1.

Further regardless of whether Coutts and Enta teach contact-based or contactless communication with an ATM, neither reference alone or in combination teaches or suggests each of the features recited in the claim.

For example, neither reference discloses or suggests that:

> when the diagnostic article is placed in operative connection with
>
> an automated banking machine the diagnostic article is operative to
>
> cause at least one controller in the machine to enable access to
>
> diagnostic data stored in the machine concerning at least one
>
> transaction function device of the machine.

Coutts does not disclose diagnostic data stored in an ATM. Nowhere in Coutts is there any mention of a data store for the storage of diagnostic data. Likewise, Figure 1 of Coutts which shows the components of Coutts' ATM, includes no data store or other means that could be used for storing diagnostic data.

Coutts further does not disclose or suggest storing diagnostic data in the ATM which concerns the operation of at least one transaction function device. In contrast, Coutts specifically teaches an ATM with sensors (22-44) which sense positions or other discrete parameters (Column 5, line 62 – Column 6, line 12). As shown in Figure 1 of Coutts, each of these sensors is directly connected to a CPU (45) which outputs signals indicating the "state of health" of the ATM (Column 4, lines 1-9).

Nowhere does Coutts teach or suggest a data store in the ATM that stores data concerning the transaction function device of the ATM, as specifically recited in claim 1. Further, nowhere does Coutts teach or suggest diagnostic data concerning a transaction function device of the ATM stored in the data store.

Further, Coutts does not teach or suggest a diagnostic article that when operatively connected with an ATM, causes a controller in the ATM to access a data store, as specifically recited in claim 1. Where does Coutts' interface device (12) cause the CPU of Coutts to access stored data in the ATM? Where does the interface device of Coutts cause the CPU of Coutts to access stored diagnostic data in the ATM?

Enta does not overcome the deficiencies in the teachings of Coutts. Enta discloses collecting failure information in a monitoring center (Column 5, lines 5-9). Enta does not disclose storing diagnostic data concerning transaction function devices in an automated banking machine. Likewise, Enta does not disclose causing a controller in an automated banking machine to access stored diagnostic data in the machine in response to placing a diagnostic article in operative connection with the machine.

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As the cited references neither disclose nor suggest the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited to combine features of the cited references so as to produce Applicants' invention, the Office has filed to establish *prima facie* obviousness. It is therefore respectfully submitted that claim 1, as well as claims 2-20 which depend therefrom, are allowable.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claim has been previously shown to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art. Neither Coutts nor Enta, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Claim 2

Claim 2 depends from claim 1. Claim 2 further recites that responsive to the service data on the article, the controller operates to cause an output from the machine that includes indicia

indicative of the significance of the stored diagnostic data that the article has caused to be accessed. These features are neither taught nor suggested in the cited art.

Coutts teaches outputting instructions on a screen (16) of an interface device which is separate from an ATM. Enta teaches a monitoring station with a display (8) which is remote from the automated transaction machines which are being monitored. Neither reference discloses or suggests a controller in an automated banking machine which is operative responsive to service data on a diagnostic article, to enable outputs through an output device of the automated banking machine.

Neither reference teaches or suggests the output of indicia indicative of significance of accessed diagnostic data concerning at least one transaction function device. Neither Coutts nor Enta discloses or suggest outputting indicia indicative of significance of such diagnostic data through an output device of an automated banking machine.

Further, neither reference discloses or suggests a controller in an automated banking machine which is operative responsive to service data on an article, to provide outputs from the machine. Neither reference discloses or suggests accessing diagnostic data concerning a transaction function device stored in the machine, responsive to connection of the machine with a diagnostic article; and responsive to the service data on the article, causing the machine to provide through its output device, indicia showing the significance of the accessed data.

The portion of Coutts cited in the Action (Column 6, lines 15-28) is devoid of all such teachings.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that claim 2 is further allowable on this basis.

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Claim 3

Claim 3 depends from claim 2. Neither Coutts nor Enta discloses or suggests a diagnostic article that causes a controller in an automated banking machine, responsive to service data included on the diagnostic article, and diagnostic data associated with a currency dispenser, to enable an output device of the machine to output indicia indicative of significance of the diagnostic data associated with the currency dispenser device.

The portion of Coutts cited in the Action (Column 5, lines 18-25) indicates that in the case of a currency jam Coutts' handheld interface device will show which ATM (10) among a group of locally located ATMs has experienced a malfunction. (See Figure 4.) This teaching neither discloses nor suggests what is recited in Applicants' claim 3.

Claim 3 specifically recites that the automated banking machine includes a currency dispenser device, and that the diagnostic data stored in the machine which is accessed in response to the article is associated with the currency dispenser device. As previously discussed, Coutts does not disclose or suggest storing data in the machine, nor does Coutts disclose or suggest storing diagnostic data concerning a transaction function device. Clearly Coutts does not disclose or suggest storing diagnostic data for a currency dispenser device. Indeed, Coutts only discloses a currency location sensor (28) which is used to detect currency in a given location (Column 6, lines 2-3). Coutts' system is only capable of detecting a currency jam adjacent these location sensors. In Coutts the sensors only give a signal of a jammed item of currency adjacent the sensors, and this is the basis upon which a user of Coutts' interface device is directed to remove a jam at the location of the sensor (Column 5, lines 37-41).

Nothing in Coutts discloses or suggests diagnostic data being stored related to a currency dispenser. Indeed, Coutts does not even disclose or suggest a sensor associated with a currency dispenser. Therefore Coutts does not disclose or suggest accessing stored diagnostic data associated with a currency dispenser in the machine in response to a diagnostic article. Further, Coutts does not disclose or suggest that a controller in the automated banking machine operates in response to the service data on a diagnostic article, and diagnostic data concerning a currency dispenser accessed from memory in the machine, to cause an output from the machine that indicates the significance of the diagnostic data associated with the currency dispenser.

Enta does not disclose or suggest the recited features of claim 3 which are not disclosed or suggested in Coutts.

As nothing in the applied art discloses or suggests the recited features, it is respectfully submitted that claim 3 is further allowable on this basis.

Claim 4

Claim 4 depends from claim 1. Claim 4 further recites that the diagnostic article includes at least one secret code. When the diagnostic article is placed in operative connection with the machine, at least one controller in the machine in response to the article including at least one secret code, enables access to at least a portion of the diagnostic data stored therein concerning at least one transaction function device.

Coutts discusses that different levels of instruction may be accessed from the interface device by using a code number input into the device by an operator (Column 3, lines 44-45). However, neither Coutts nor Enta discloses nor suggests that when a diagnostic article that

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includes a secret code is placed in operative connection with an automated banking machine, at least one controller in the machine enables access to at least a portion of stored diagnostic data concerning transaction function devices responsive to the article including the at least one secret code.

As nothing in the applied art discloses or suggests the recited features, it is respectfully submitted that the claim is further allowable on this basis.

Claim 6

Claim 6 depends from claim 4. Claim 6 further recites that at least a portion of the diagnostic data stored in the banking machine concerning at least one transaction function device, is enabled to be accessed by at least one controller in the machine in response to the diagnostic article including at least one secret code and at least one input to an input device on the automated banking machine.

Although Coutts discloses inputs to its interface device, neither Coutts nor Enta disclose nor suggest a controller in an automated banking machine which is responsive to both a diagnostic article being placed in operative connection with the machine and an input to an input device of the automated banking machine to enable access to at least a portion of diagnostic data concerning transaction function devices stored on the machine. Although Coutts discusses the use of an input to his interface device for purposes of enabling the operation thereof, Coutts clearly does not suggest the use of at least one secret code on a diagnostic article and at least one input to an input device of the automated banking machine, for purposes of enabling operation. Indeed, Coutts specifically teaches that one of the advantages of his invention is that it does not require an operator to access the ATM, and therefore avoids the ATM being shut down (Column

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1, lines 25-29). Therefore it would appear that Coutts specifically teaches against a user performing diagnostic functions from providing inputs directly to input devices of the automated banking machine.

Enta does not provide any teaching or suggestion which overcomes the deficiencies in the teaching of Coutts.

As nothing in the applied art discloses or suggests the additionally recited features of claim 6, it is respectfully submitted that the claim is further allowable on this basis.

Claim 7

Claim 7 depends from claim 3. Claim 7 further recites that the diagnostic article includes service manual data. When the article is placed in operative connection with the automated banking machine, a controller in the machine is operative to enable output of indicia corresponding to service manual data through at least one output device on a machine. Such features are neither disclosed nor suggested in Coutts or Enta.

Coutts discloses an interface terminal which outputs instructions. However, neither Coutts nor Enta discloses or suggests a controller in an automated banking which is operative to enable output of indicia corresponding to service manual data read from a diagnostic article, through an output device on the automated banking machine. Coutts teaches nothing regarding storing data corresponding to a service manual for a banking machine on a diagnostic article. Further, Coutts does not disclose or suggest providing instructions, whether based on a service manual or otherwise, from an output device of the automated banking machine. Indeed, Coutts specifically teaches that an advantage of his system is avoiding the need for the user to have direct contact with the automated banking machine. Further, nothing in any of the applied

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references teaches or suggests operating at least one controller in an automated banking machine in response to data on a diagnostic article placed in operative connection with the machine, to output indicia corresponding to service manual data from the machine.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that the claim is further allowable on this basis.

Claim 10

Claim 10 depends from claim 3. Claim 10 further recites that the diagnostic article includes browser software. Responsive to the diagnostic article being placed in operative connection with the automated banking machine, at least one controller of the machine is operative to load the browser software from the diagnostic article. Nothing in the cited art discloses or suggests these features and relationships.

Although Coutts discloses displaying a sequence of instructions through an interface device, neither Coutts nor Enta discloses or suggests a controller of an automated banking machine which is operative to load browser software from a diagnostic article placed in operative connection with the machine. Further, nothing in the cited art discloses or suggests browser software. Nothing in the cited art discloses or suggests browser software on a diagnostic article, or a controller of a banking machine operating to load browser software from such a diagnostic article.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that the claim is further allowable on this basis.

Claim 11

Claim 11 depends from claim 10. Claim 11 further recites that the service data on the diagnostic article is adapted to be processed by the browser software that is resident on and loaded by the banking machine from the article. Claim 11 further recites that when the diagnostic article is in operative connection with the automated banking machine, at least one controller of the machine is operative to process the service data from the article through operation of the browser software. In response to processing of the service data with the browser software, the controller of the banking machine is operative to output indicia through an output device on the machine.

Neither Coutts nor Enta disclose service data included on a diagnostic article which is adapted to be processed by browser software. Nothing in the cited references discloses or suggests loading browser software by a controller of an automated banking machine from a diagnostic article. Further, neither reference discloses or suggests, a controller of an automated banking machine which is operative to process the service data from an article using the browser software loaded from a diagnostic article, and to output indicia through at least one output device of the automated banking machine.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that the claim is further allowable on this basis.

Claim 12

Amended claim 12 depends from claim 11. Claim 12 further recites that the browser software that is loaded from the diagnostic article, is adapted to interpret nonstandard embedded instructions in the service data that is read from the diagnostic article

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Neither Coutts nor Enta discloses or suggests browser software. Neither reference discloses or suggests browser software that is adapted to interpret nonstandard embedded instructions in service data.

As nothing in the applied art discloses or suggests these features, it is respectfully submitted that the claim is further allowable on this basis.

Claim 13

Claim 13 depends from claim 1. Claim 13 further recites that the diagnostic article includes diagnostic instructions. When the diagnostic article is placed in operative connection with the banking machine, a controller in the machine operates in response to the diagnostic instructions to cause the controller to interact with at least one of the transaction function devices of the machine to conduct at least one diagnostic test. Neither of the cited references discloses or suggests these features and relationships.

Neither Coutts nor Enta disclose or suggest a controller of an automated banking machine which is operative responsive to diagnostic instructions included on a diagnostic article placed in operative connection with the automated banking machine, to cause the controller to interact with at least one of a plurality of transaction function devices in the machine to conduct at least one diagnostic test. Nothing in Coutts nor Enta discloses or suggests a diagnostic article that causes a controller in a banking machine to access diagnostic data associated with at least one transaction function device in the machine, and causes the controller to interact with at least one of the transaction function devices to conduct at least one diagnostic test.

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As nothing in the applied art discloses or suggests these features, it is respectfully

submitted that the claim is further allowable on this basis.

Claim 14

Claim 14 depends from claim 13. Claim 14 further recites that the diagnostic article is

operative to cause a controller in the banking machine, in response to the service data on the article

and the result of at least one diagnostic test conducted in response to the article, to cause the output

of indicia through an output device of the machine which corresponds to at least one remedial

action. The cited references neither disclose nor suggest these features and relationships.

Coutts discloses displaying instructions on its interface device. However, neither Coutts

nor Enta discloses or suggests a controller of an automated banking machine which outputs

indicia through an output device on the automated banking machine corresponding to a remedial

action. Further, neither reference discloses or suggests that service data included on a diagnostic

article is operative to cause a controller in the automated banking machine to carry out at least

one diagnostic test, and to cause the output of the indicia through the output device on the

automated banking machine in response to the service data and the result of the at least one

diagnostic test.

As nothing in the applied art discloses or suggests these features, it is respectfully

submitted that the claim is further allowable on this basis.

Claim 15

Claim 15 depends from claim 13. Claim 15 further recites that the diagnostic article,

which is operative to cause the accessing of diagnostic data of a banking machine, cause the

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execution of at least one diagnostic test by the banking machine, and to cause the banking machine to output remedial actions, can also be placed in operative connection with a computer that is not part of an automated banking machine. When such diagnostic article is placed in communication with a non-banking machine computer, the diagnostic constructions are not executed.

Nothing in Coutts discloses or suggests the ability to place Coutts' interface device in operative connection with a device other than an automated banking machine. Where does Coutts even suggest attempting to put his interface device in operative connection with some other type of computer? Coutts does not disclose or suggest that his interface device be placed in operative connection with a computer that is not in operative connection with an ATM. Neither Coutts nor Enta discloses or suggests a diagnostic article with diagnostic instructions that are not executed when the diagnostic article is placed in operative connection with a computer device that is not in operative connection with an automated banking machine.

As the cited references neither disclose nor suggest the features and relationships specifically recited in claim 15, claim 15 is further allowable.

Claim 18

Claim 18 depends from claim 3. Applicants respectfully submit that the recited phrase of "indicating significance of . . ." is clear and definite and is an additional feature which distinguishes the claim from the applied art. Support for this feature is found in the Specification for example at page 61, lines 2-6 wherein it is stated that "In the exemplary embodiment engaging the diagnostic article in operative connection with the controller enables a servicer to obtain access to the diagnostic data as well as to access information from the article

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which provides an indication of the significance of the diagnostic data being received." For purposes of the application, "significance" is given its ordinary meaning, which Webster's New World dictionary defines as "importance" or "meaning". Applicants respectfully submit that the terminology is definite and further defines the claimed form of the invention.

Claim 18 depends from 3 and further recites that the controller in the machine is operative responsive to the service data on the article to enable outputs through at least one output device of the machine which indicates significance of at least a portion of the diagnostic data associated with the currency dispensers. Nothing in the applied art discloses or suggests accessing service data stored in an ATM concerning a currency dispenser. Further, nothing in the applied art discloses or suggests an article which causes a controller in a banking machine to operate in response to the service data and the diagnostic data to output information on the machine that provides a user with an indication of the significance (i.e. the importance or meaning) of the diagnostic data that has been accessed.

As nothing in any of the applied references discloses or suggests these features and relationships, it is respectfully submitted that claim 18 is further allowable.

Claim 19

Claim 19 depends from claim 18, which recites an automated banking machine. Claim 19 further recites that the automated banking machine includes at least one data store, and that the diagnostic data is stored in protected relation in the at least one data store. It is further recited that the controller enables indicia corresponding to at least a portion of the diagnostic data to be output through the at least one output device on the machine, only when the

diagnostic article is in operative connection with the at least one controller. Nothing in the prior art discloses or suggests these features.

The Action asserts that in Coutts diagnostic data is stored on an ATM. Applicants respectfully disagree. The portion of Coutts pointed to in the Action (Column 6, lines 15-30) does not disclose that diagnostic data is stored on an ATM. Rather, the cited portion of Coutts specifically indicates that state of health information is requested by an operator through the interface device. In response to the query, the CPU (45) shown in Figure 1 of Coutts, outputs a signal indicative of the status of the sensors (22-44) that are connected to the CPU. Nothing in Coutts discloses or suggests a data store, which includes diagnostic data concerning at least one transaction function device being stored therein.

Further, claim 19 specifically recites that the diagnostic data is stored in protected relation in the data store. This storing of diagnostic data in protected form is specifically discussed in Applicants' Specification at Page 60, lines 8-15. Nothing in Coutts or Enta discloses or suggests storing diagnostic data in a data store in a banking machine. Clearly, nothing in any of the cited art discloses or suggests storing diagnostic data in such a data store in protected form.

Neither Coutts nor Enta discloses or suggests providing outputs through an output device on a banking machine. Further, neither reference discloses or suggests that a controller of the automated banking machine enables indicia corresponding to at least a portion of the diagnostic data to be output through an output device on the automated banking machine, only when the diagnostic article is in operative connection with the controller.

As the cited references neither disclose nor suggest the features and relationships which are specifically recited, claim 19 is further allowable for these reasons.

Claim 20

Claim 20 depends from claim 18. Claim 20 additionally recites that responsive to the diagnostic article being placed in operative connection with a controller of the banking machine, the controller is enabled to conduct at least one diagnostic test. Claim 20 further recites that the at least one diagnostic test includes operation of at least one transaction function device. The cited references neither disclose nor suggest these features.

The Action asserts that Coutts discusses a procedure for rectifying a malfunction due to currency jamming (Column 5, lines 19-41). This procedure involves displaying instructions on the handheld interface device which prompt an "operator to remove the jammed currency". However, neither Coutts nor Enta discloses or suggests that a controller of an automated banking machine is enabled to conduct at least one diagnostic test operation, including operation of at least one of the transaction function devices of the machine, responsive to the diagnostic article being placed in operative connection with the at least one controller.

As the cited references neither disclose nor suggest the features and relationships, claim 20 is further allowable for these reasons.

Claim 17 is Not Obvious Over
Coutts in view of Enta and Simmons

In the Action claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Coutts as modified by Enta as applied to claim 1, in view of Simmons. This rejection is respectfully traversed. Applicants' response to these rejections is based on the Office's

referenced interpretations of Coutts, Enta, and Simmons. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

Claim 17 depends from claim 16. Claim 16 was indicated to be allowable but for dependence on a rejected base claim. Thus, claim 17 should likewise be listed as allowable but objected to under the Disposition of Claims on the Office Action Summary sheet PTOL-326, and should not be subject to a rejection under 35 U.S.C. § 103(a).

In addition, please note that the reference of Simmons used as a basis for rejecting claim 17 is not listed on form PTO-892.

The New Claims

As discussed previously, new claims 21-24 correspond respectively to the features and relationships in allowable claims 5, 8, 9, 16. Also new claim 25 corresponds to original claim 17 and depends from new claim 24. It is respectfully submitted that these new claims should be allowed.

New claim 26 generally corresponds to original claim 1 and recites the phrase "portable storage medium" in place of the phrase "diagnostic article" recited in claim 1. Claim 26 further recites that the at least one output device is included in the automated banking machine. It is respectfully submitted that claim 26 is allowable on the same basis as claim 1. Specifically and

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without limitation, the cited art does not disclose or suggest a portable diagnostic medium which causes a controller of a banking machine, to access diagnostic data concerning transaction function devices when placed in operative connection with a banking machine. Further, the cited references neither teach nor suggest such a portable storage medium which is additionally operative to cause a controller of a banking machine, to cause output of indicia through an output device on the machine responsive to service data included on the portable medium. Indeed, the teachings of Coutts are contrary to those of the recited invention, as Coutts seeks to avoid use of output devices on a banking machine in conjunction with his system. For all these reasons, new claim 26 should be allowed.

New claims 27-29 depend from claim 26 and recite that the portable storage medium comprises a CD, DVD, and portable flash memory device, respectively. The cited references neither disclose nor suggest a portable storage medium of this type including the recited features. It is respectfully submitted that the cited art neither discloses nor suggests the features recited in these dependent claims or in the base claim.

New claim 30 is an independent claim which recites encryption and decryption features indicated as novel and nonobvious subject matter in conjunction with allowable claim 8. It is respectfully submitted that claim 30 is allowable on this basis. In addition, new claim 30 specifically recites that visual information is provided through a display device of an ATM, responsive to service data read from the diagnostic article and diagnostic data which concerns at least one operational characteristic of a transaction device stored in at least one data store of the ATM. Nothing in the cited art discloses or suggests these features, and claim 30 is further allowable for these reasons.

New claims 31-44 depend from claim 30 and recite features previously recited in the original dependent claims 2-20. It is respectfully submitted that each of these claims is allowable for the reasons discussed in conjunction with the base claim as well as with each of claims 2-20, the arguments relating thereto being incorporated herein by reference.

New claim 45 is an independent claim which generally corresponds to original claim 13. The arguments previously made regarding claim 13 are incorporated herein by reference. The cited references do not disclose or suggest a portable storage medium that is operative to cause a controller in an automated banking machine, to access diagnostic data stored in a data store in the machine, which diagnostic data concerns at least one transaction device. Further, the cited references do not teach or suggest a portable storage medium that when place in operative connection with a banking machine, causes at least one controller in the machine to output indicia through an output device of the machine responsive to service data included on the diagnostic article. Further, the cited references neither disclose nor suggest a portable diagnostic medium that causes a controller in a banking machine, in response to diagnostic instructions on the medium, to cause at least one transaction function device to operate to conduct at least one diagnostic test. For all these reasons, it is respectfully submitted that claim 45 is allowable.

New claims 46-48 depend from claim 42 and recite that the portable storage medium comprises a CD, DVD, and portable flash memory device, respectively. The cited art neither discloses or suggests these features.

New claim 49 is an independent claim that generally corresponds to the features recited in claims 3 and 7. It is respectfully submitted that new claim 49 is allowable on the same bases, and the arguments in support of claims 3 and 7 are incorporated herein by reference. The cited

art neither discloses nor suggests, among other things, computer readable media that includes computer executable instructions which include service manual data, which corresponds to a plurality of service procedures for a cash dispensing automated banking machine. Further, the prior art neither discloses nor suggests such an article with instructions that are operative to cause a processor in an automated banking machine to access diagnostic data stored in at least one data store of the machine, that concerns operation of at least one transaction function device including a currency dispenser. Further, the cited art neither discloses nor suggests such an article which causes at least one processor in a banking machine, to operate in response to service manual data on the article and accessed diagnostic data, to output from an output device on the banking machine, indicia corresponding to at least one service procedure for the machine. As such features and relationships are absent from the prior art, claim 49 is allowable.

Claim 50 depends from claim 49 and further recites features and relationships that generally correspond to claims 10 and 11. The arguments in support of claims 10 and 11 are incorporated herein by reference. Claim 50 further recites that the instructions including service manual data on the article are processed through operation of browser software. Claim 50 further recites that when the article is in operative connection with the banking machine, browser software operating in at least one processor of the machine operates to cause indicia corresponding to the service procedure to be output through at least one output device of the machine. Nothing in the cited art discloses or suggests these features, and claim 50 is further allowable for this reason.

Claim 51 depends from claim 49 and further recites the features and relationships corresponding to claims 4 and 19. The arguments in support of claims 4 and 19 are

incorporated herein by reference. Claim 51 recites that the instructions on the diagnostic article are operative to enable at least one processor in the banking machine, to access diagnostic data that is stored in a protected form in at least one data store in the machine. Claim 51 further recites that at least one processor in the machine is operative responsive to the instructions, to access the protected form of the diagnostic data stored in the machine and to cause the output of indicia from the machine responsive to the protected diagnostic data accessed. Nothing in the cited art discloses or suggests these features, and it is respectfully submitted that claim 51 is further allowable for these reasons.

Claim 52 depends from claim 49 and further recites features previously discussed in connection with claim 4. The arguments in support of claim 4 are incorporated herein by reference. Claim 52 further recites that the instructions on the article include at least one secret code, and that at least one processor of the machine operates to authenticate the article responsive to the at least one secret code. The claim further recites that the at least one processor is operative responsive to successfully authenticating the article, to cause the output of the indicia from the machine. Nothing in the cited art discloses or suggests these features.

Claim 53 depends from claim 49 and further recites features previously discussed in connection with claims 13 and 14. The arguments in support of claims 13 and 14 are incorporated herein by reference. Claim 53 further recites that the instructions on the diagnostic article are operative to cause the banking machine to carry out at least one diagnostic test, which includes operation of at least one transaction function device that causes currency to be dispensed from the machine. Claim 53 further recites that the instructions on the article are operative to cause a processor in the machine to carry out the at least one diagnostic test and to

determine at least one result therefrom. Indicia corresponding to the result are output from the output device of the banking machine. Nothing in the cited art discloses or suggests these features, and it is submitted that claim 53 is further allowable for these reasons.

Support for these new claims in found in the Specification, original claims and drawings. No new matter has been added. None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claims 21-53.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Comments

Applicants request acknowledgment of their claim for domestic priority. This Application claims benefit pursuant to 35 U.S.C. § 119(e) of Provisional Application Serial Numbers: 60/429,249 filed November 25, 2002; 60/429,250 filed November 25, 2002; 60/429,476 filed November 26, 2002; 60/429,521 filed November 26, 2002; 60/429,528 filed November 26, 2002; 60/453,370 filed March 10, 2003; and 60/465,733 filed April 25, 2003.

Additional Claim Fees

Please charge the fees associated with prosecution of five additional independent claims in excess of 3 ($1,000) and 33 additional total claims ($1,650) and any other fee due, to Deposit Account No. 09-0428 of InterBold.

Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

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